

**REMARKS**

Favorable reconsideration of this application is respectfully requested in view of the following remarks.

This Amendment is being filed concurrently with a Request for Continued Examination and is filed in response to the recently issued Advisory Action.

To avoid the possibility that the notch-shaped channel disclosed in *Leyensetter* is broadly interpreted as being the same as the channel recited in Claim 2 which is defined by the cylindrical inner periphery of the blind hole and a flat cut surface on the outer periphery of a portion of the second member, Claim 2 has been amended to recite that the flat cut surface lies in a single plane and has its longitudinal side edges in contact with the cylindrical inner periphery of the blind hole.

As pointed out in the Amendment filed on July 7, 2005, *Leyensetter* lacks disclosure of a channel though which any gap present between the bottom of the second member and the bottom of the blind hole is in communication with the outside of the blind hole, wherein the channel is defined by a cylindrical inner periphery of the blind hole and a flat cut surface formed on the outer periphery of a portion of the second member which is press-fit into the hole. The Advisory Action issued on July 22, 2005 states that *Leyensetter* is relied upon for the general disclosure of a channel, not a specific shape of a channel. The Advisory Action goes on to observe that even though *Leyensetter* does not disclose a channel defined by a cylindrical inner periphery of the blind hole and a flat cut surface formed on the outer periphery of a portion of the second member which is press-fit into the hole, differences in shape are generally not patentable. The Advisory Action cites

§ 2144.04 of the Manual of Patent Examining Procedure to support this latter proposition. That section of the Manual of Patent Examining Procedure refers to *In re Dailey*, 357 F.2d, 669, 149 USPQ 47 (CCPA 1966) and summarizes the court's holding in that case in the following manner.

The court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.

Thus, the Manual of Patent Examining Procedure does not suggest that differences in shape are generally not patentable. Rather, what the Manual of Patent Examining Procedure indicates is that the court in *In re Dailey* found that the shape of the container was a matter of choice which an ordinarily skilled artisan would have found obvious because there was no significance attributed to the claimed container shape. Here, though, there is significance associated with the claimed configuration of the channel, and the claimed configuration of the channel is not merely a matter of choice which one of ordinary skill in the art would have found obvious.

As explained in the Amendment filed on July 7, 2005, when the second member is pressed into the blind hole of the first member, the two members have a tendency to scrape against one another and thus produce burrs. These burrs can drop into the gap that is present between the bottom of the second member and the bottom of the blind hole. If burrs are present in this gap, the burrs can flow through the channel together with hydraulic oil and can mix into the hydraulic oil circulating in the brake circuit. The brake circuit includes a large number of valves, and if burrs mix into the brake circuit, the burrs may get stuck between the valve body and the

valve seat of one or more of the valves. If a thick or large burr becomes stuck between the valve body and the valve seat, it is possible that the valve will not be able to close completely or properly. This problem is not as likely to occur if the burrs are thin or small. The claimed channel configuration at issue here, defined by a cylindrical inner periphery of the blind hole and a flat cut surface formed on the outer periphery of a portion of the second member which is press-fit into the hole, helps avoid the possibility that large or thick burrs will become mixed into the brake circuit.

To explain this in more detail, attached is a copy of the attachment that was submitted with the Amendment filed on July 7, 2005. The attachment includes two series of illustrations provided for explanatory purposes. Illustrations 1a and 1b show the general relationship between the blind hole and the second member before and after the second member is pressed into the blind hole, and depicting the channel configuration recited in Claim 2. Illustrations 2a and 2b show the general relationship between the blind hole and the second member before and after the second member is pressed into the blind hole, and depicting the notched channel described in *Leyensetter*.

Illustration 1b shows the channel configuration recited in Claim 2 in which the channel is defined by the cylindrical inner periphery of the blind hole and the flat cut surface on the outer periphery of a portion of the second member. As can be seen, the cross-section of this channel is rather small or narrow. On the other hand, illustration 2b shows that the notch-shaped channel described in *Leyensetter* possesses a larger cross-section.

A comparison of illustrations 1b and 2b of the attachment makes clear that the channel defined by the cylindrical inner periphery of the blind hole and the flat cut surface on the outer periphery of a portion of the second member possesses a much narrower cross-section as compared to the notch-shaped channel described in *Leyensetter*. Thus, by employing a channel configured in the manner recited in independent Claim 2, only relatively thin burrs in the gap resulting from the second member being pressed into the blind hole of the first member are able to pass through the channel. On the other hand, because the notch-shaped channel described in *Leyensetter* possesses a larger cross-section, larger burrs can pass through the channel. As discussed above, larger burrs which pass through the channel and become stuck between the valve body and the valve seat can adversely affect the ability of the valve to completely or properly close.

It is thus seen that the claimed channel recited in independent Claim 2 is not a mere matter of choice. Indeed, the claimed channel configuration avoids difficulties that can arise using the notch-shaped channel described in *Leyensetter*. The claimed channel is also a good bit easier to form than the notch-shaped channel described in *Leyensetter*. Absent recognition in the art of the shortcomings associated with the notch-shaped channel described in *Leyensetter*, there would have been no reason for an ordinarily skilled artisan to consider utilizing a channel having a configuration different from the notch-shaped channel described in *Leyensetter*. Further, absent a disclosure in the art that a channel configured in the manner recited in Claim 2 is not as susceptible to the shortcomings associated with the notch-shaped channel described in *Leyensetter*, and provides advantages relative to a notch-shaped channel, an ordinarily skilled artisan would not have been

motivated to utilize a channel defined by a cylindrical inner periphery of the blind hole and a flat cut surface formed on the outer periphery of a portion of the second member which is press-fit into the hole as recited in Claim 2.

It is thus respectfully submitted that the combined disclosures contained in *Ariki et al.* and *Leyensetter* would not have directed one to utilize a channel defined by the cylindrical inner periphery of the blind hole and the flat cut surface on the outer periphery of a portion of the second member as recited in independent Claim 2. Accordingly, withdrawal of the rejection of record and allowance of this application are earnestly solicited.

Should any questions arise in connection with this application or should the Examiner believe that a telephone conference with the undersigned would be helpful in resolving any remaining issues pertaining to this application, the undersigned respectfully requests that he be contacted at the number indicated below.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

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By: Matthew L. Schneider

Matthew L. Schneider  
Registration No. 32,814

P.O. Box 1404  
Alexandria, Virginia 22313-1404  
(703) 836-6620